

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on February 4, 2009

PATENT
Docket No.: 082368-002810US
Client Ref. No.: ONC-A0216P2-US

TOWNSEND and TOWNSEND and CREW LLP

By: /Megan McCoy/
Megan McCoy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yusuke NAKAMURA, et al.

Application No.: 10/529,381

Filed: November 28, 2005

For: GENES AND POLYPEPTIDES
RELATING TO PROSTATE CANCERS

Customer No.: 20350

Confirmation No.: 8925

Examiner: Rawlings, Stephen L.

Art Unit: 1643

**REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT
DETERMINATION
UNDER 37 C.F.R. § 1.705(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Pursuant to 37 C.F.R. § 1.705(b), Applicants respectfully request reconsideration of the patent term adjustment determination. This request is accompanied by the fee set forth in §1.18(e) and a statement of facts as required under 37 C.F.R. § 1.705(b)(2).

In view of the following it is respectfully requested that Applicants be granted a minimum patent term adjustment of **498 days**, with an additional term to be added if the patent issues after May 19, 2009 (which is the Tuesday prior to 28 weeks after the mailing date of the Notice of Allowance).

Statement of Facts as required under 37 C.F.R. § 1.705(b)(2)

The correct patent term adjustment is 498 days, not 326 days as stated on the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed on November 6, 2008 with the Notice of Allowance.

The period of adjustment under § 1.702(a) is 331 days ("A delay").

The period of adjustment under § 1.702(b) is to be determined when the instant application issues. The effective period of adjustment under 37 C.F.R. § 1.702(b) is 172 days ("B delay").

The period adjustment under § 1.704(a) is 5 days ("applicant delay").

The period of adjustment under § 1.703(f) is 498 days.

The Relevant Dates as Specified in 37 C.F.R. §§ 1.703(a)-(e) and the Adjustment Specified in 37 C.F.R. § 1.703(f)

1. § 1.703(a)

Applicants submit that the Office did correctly calculate the term adjustments to include the term adjustments that Applicants are entitled under 37 CFR § 1.703(a)(1) and § 1.703(a)(3) to be 331 days. (See **Exhibit A**, attached hereto) The relevant § 1.703(a)(1) dates are shown below.

Filing Date	14-month Date	Date of 1 st Restriction Requirement	Days over 14 months (§ 1.703(a)(1))
November 28, 2005	January 28, 2007	December 12, 2007	318 days

Applicants acknowledge that the Office has correctly determined the adjustment under § 1.703(a)(3) to be 13 days as defined under § 154(b)(1)(A).

Date of Applicant Reply	4-month Date	Date of mailed PTO Response	Days over 4 months (§ 1.703(a)(3))
June 18, 2008	October 18, 2008	October 31, 2008	13 days

Applicants, however, respectfully request an additional period of adjustment equal to the number of days, if any, in the period beginning on the day after the date that is four months after the date on which the issue fee will be paid and all outstanding requirements are

satisfied and ending on the date the patent issues. *See*, 35 U.S.C. §154(b)(1)(A)(iv), 37 C.F.R. § 1.702(a)(4) and § 1.703(a)(6).

2. § 1.703(b)

The Office failed to issue a patent within three years of the actual filing date of the above-referenced application. The period of adjustment under 37 C.F.R. § 1.702(b) begins on the day after the date that is three years from the filing date of the instant application, November 28, 2008, and ends on the day the patent is issued. The Notice of Allowance was mailed on November 6, 2008. If the patent issues approximately 28 weeks from the mailing of the Notice of Allowance, the estimated date of issuance is May 19, 2009 (rounded to nearest Tuesday).

Thus, the effective period of adjustment under 37 C.F.R. § 1.702(b) is **172 days**, i.e., from November 28, 2008 to May 19, 2009 as shown in the table below.

Filing Date	3-year Date	Date of Notice of Allowance	28-weeks from Notice of Allowance	Estimated days over 3 years through Issuance (§ 1.703(b)(1))
November 28, 2005	November 28, 2008	November 6, 2008	May 19, 2009	172 days

3. § 1.703(c)-(e)

There are no relevant dates as specified under §§ 1.703(c)-(e)

4. Overlapping periods under § 1.703(a)-(e)

Applicants have calculated overlapping periods in accordance with *Wyeth v. Dudas* (Case No. 07-1492, D.D.C. 2008). Thus, the periods of delay under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §1.54(b)(1)(B) overlap only if they occur on the same calendar day or days.

There are **no** overlapping periods under §§ 1.703(a)-(e).

5. § 1.703(f)

The period of adjustment under 37 C.F.R. § 1.702(f) is as follows:

Type "A" delay:	331 days
Type "B" delay:	172 days
"A" and "B" overlap:	0 days
<u>Adjusted</u>	<u>503 days</u>

As discussed above, Applicants respectfully request an additional period of adjustment equal to the number of days, if any, under 37 C.F.R. § 1.703(a)(6). Any such period of adjustment under 37 C.F.R. § 1.703(a)(6) begins on May 19, 2009 will not overlap with a period of adjustment under 37 C.F.R. § 1.702(b).

Reduction of Period of Adjustment of Patent Term Under 37 C.F.R. §1.704

The correct period of adjustment under § 1.704(a) is 5 days as indicated by the Patent Term Adjustment History (*see Exhibit A*).

Terminal disclaimer

The instant application is not subject to a terminal disclaimer.

PATENT TERM ADJUSTMENT DETERMINATION

Applicants are entitled to 498 days of patent term adjustment, *i.e.*, [503 days (A delay + B delay)] minus [5 days (applicant delay)]. Applicants are also entitled to any period of adjustment under 37 C.F.R. § 1.703(a)(6).

CONCLUSION

Please charge the fee set forth in 37 C.F.R. §1.18(e) (\$200.00) to Deposit Order Account No. 20-1430. Please charge any necessary additional fees or credit any overpayments to our Deposit Order Account No. 20-1430.

Based on the foregoing, Applicants respectfully request reconsideration of the patent term adjustment determination.

Respectfully submitted,



Carol P. Johns
Reg. No. 50,463

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
Attachments: *Exhibit A* (2 pages)

CPJ:m4m

EXHIBIT A

10/529,381	GENES AND POLYPEPTIDES RELATING TO PROSTATE CANCERS	02-04-2009::13:40:12
------------	---	----------------------

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/529,381

Filing or 371(c) Date:	11-28-2005	USPTO Delay (PTO) Delay (days):	331
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	5
Post-Issue Petitions (days):	+0	Total PTA (days):	326
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
11-06-2008	Mail Notice of Allowance		
11-05-2008	Document Verification		
11-05-2008	Notice of Allowance Data Verification Completed		
11-05-2008	Case Docketed to Examiner in GAU		
11-05-2008	Examiner's Amendment Communication		
10-15-2008	Examiner Interview Summary Record (PTOL - 413)		
11-04-2008	Mail Examiner Interview Summary (PTOL - 413)		
10-15-2008	Examiner Interview Summary Record (PTOL - 413)		
10-31-2008	Mail Examiner Interview Summary (PTOL - 413)		
10-31-2008	Mail Examiner Interview Summary (PTOL - 413)		
10-31-2008	Mail Miscellaneous Communication to Applicant	13	
10-31-2008	Miscellaneous Action with SSP	⬆	
10-15-2008	Examiner Interview Summary Record (PTOL - 413)	⬆	
10-01-2008	Examiner Interview Summary Record (PTOL - 413)	⬆	
07-22-2008	Date Forwarded to Examiner	⬆	
06-23-2008	Supplemental Response		5
06-18-2008	Oath or Declaration Filed (Including Supplemental)		⬆
07-11-2008	Date Forwarded to Examiner		⬆
06-18-2008	Response after Non-Final Action		⬆
02-11-2008	Amendment Crossed in Mail		
03-19-2008	Mail Non-Final Rejection		
03-14-2008	Non-Final Rejection		
12-19-2006	Information Disclosure Statement considered		
11-28-2005	Information Disclosure Statement considered		
02-28-2008	Case Docketed to Examiner in GAU		
01-17-2008	Date Forwarded to Examiner		
01-14-2008	Response to Election / Restriction Filed		
12-12-2007	Mail Restriction Requirement	318	
12-10-2007	Requirement for Restriction / Election	⬆	
06-28-2007	Case Docketed to Examiner in GAU	⬆	
12-19-2006	Information Disclosure Statement (IDS) Filed	⬆	

EXHIBIT A -- cont.

12-19-2006	Information Disclosure Statement (IDS) Filed	⬆
05-10-2006	IFW TSS Processing by Tech Center Complete	⬆
11-28-2005	Information Disclosure Statement (IDS) Filed	⬆
11-28-2005	Information Disclosure Statement (IDS) Filed	⬆
11-28-2005	Preliminary Amendment	⬆
05-10-2006	Case Docketed to Examiner in GAU	⬆
04-22-2006	Cleared by OIPE CSR	⬆
04-19-2006	Cleared by OIPE CSR	⬆
04-19-2006	Cleared by OIPE CSR	⬆
11-28-2005	371 Completion Date	⬆
04-17-2006	Application Dispatched from OIPE	⬆
04-17-2006	Notice of DO/EO Acceptance Mailed	⬆
11-28-2005	Additional Application Filing Fees	⬆
11-28-2005	Information Disclosure Statements	⬆
11-28-2005	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	⬆

Close Window